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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/588,679	05/29/2007	Gavril W. Pasternak	62078(51590)	5097

21874 7590 03/31/2008

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EXAMINER	
LANDSMAN, ROBERT S	

ART UNIT	PAPER NUMBER
1647	

MAIL DATE	DELIVERY MODE
03/31/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/588,679	PASTERNAK ET AL.	
	Examiner	Art Unit	
	ROBERT LANDSMAN	1647	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *1* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *8/8/06 (Preliminary Amendment)*.

2a)☐ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-21* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) *1-21* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. Lack of Unity

A. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in response to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-20, as drawn to isolated MOR splice variant polypeptide, encoding and fully complementary polynucleotides and methods for screening compounds.

Group II, claims 8-13, as drawn to antisense polynucleotides.

Group III, claim 21, drawn to a method of regulating morphine analgesia.

The invention listed as Groups I-III do not relate to a single inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical feature for the following reasons: the special technical feature of Group I is isolated MOR splice variant polypeptide. The special technical feature of Group II is an antisense. The special technical feature of Group III is a method of regulating morphine analgesia. The special technical feature of each group is not the same, or does not correspond to the special technical feature of any other Group. The products of Groups I-II are structurally and functionally distinct, and the methods of Group I and III require different method steps and reagents for achieving different goals. The Groups are not linked by a special technical feature within the meaning of PCT Rule 13.2 so as to form a single inventive concept.

The inventions listed as Groups I and II, and the polypeptides used in Group III, do not meet the requirements for Unity of Invention or the following reasons:

The polypeptides listed in Group I (SEQ ID NO:50, 52, 54, 56, 58 and 60) and their encoding polynucleotides (SEQ ID NO:51, 53, 55, 57, 59 and 61), or the antisense to these polynucleotides listed in Group II, or the methods using the polypeptides of Group I (i.e. Group III) are drawn to separate, distinct inventions and are distinguished from each other because the special technical features which define them by chemical and physical characteristics i.e. structure/function, as well as biological functions are different and these special technical features are not shared by each invention. Since these special technical features are not shared by each product and since the common features do not establish an

advance over the prior art, the inventions (i.e. independent SEQ ID NOs) of Groups I, II and III do not form a single inventive concept within the meaning of Rule 13.2

Therefore, in order to be fully responsive, in addition to electing a Group, Applicants must also elect one separate, distinct polypeptide (SEQ ID NO:50, 52, 54, 56, 58 or 60) and its encoding polynucleotide (SEQ ID NO:51, 53, 55, 57, 59 or 61). If Applicants elect Group II, a specific polynucleotide must be elected. These polypeptides, antisense molecules and method could have been placed into 18 Groups, but were combined for ease of understanding.

The antisense molecules were placed into Group II since antisense is not the same as a "complementary nucleic acid," which appears in Group I.

Furthermore, if Group III is elected, Applicants must further elect one of (1) antigen binding fragments (2) agonists and antagonists (3) small molecules or (4) antisense. The inventions listed as Group III do not relate to a single inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical feature for the following reasons – Rossi et al. (FEBS Letters 369, 1995 - reference CA and duplicate reference CG1 on the 1449 filed 2/27/07) teach the use of MOR-1 antisense to block morphine analgesia in rats (Abstract). Since these special technical features do not establish an advance over the prior art, the inventions do not form a single inventive concept.

Advisory information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Landsman, Ph.D. whose telephone number is (571) 272-0888. The examiner can normally be reached on M-F 10 AM – 6:30 PM (eastern).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Manjunath Rao can be reached on 571-272-0939. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Robert Landsman/
Primary Examiner, Art Unit 1647